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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,999

02/02/2005

David H. Behnen

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4662

7590

03/13/2007

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EXAMINER

GRAY, LINDA LAMEY

ART UNIT

PAPER NUMBER

1734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/522,999

Applicant(s)

BEHNEN, DAVID H.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-30-04, 2-2-05, 4-20-05, and 5-9-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 11, 13, 16 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:

Group I: claims 1 – 9, drawn to a product, 283/61, and

Group 2: claims 10 – 20, drawn to a method, 156/270.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The method has a special technical feature of bonding laminates with UV light that is not set forth by the product claims.

3. During a telephone conversation with Attorney Michael A. Mann on January 16, 2007 a provisional election was made without traverse to prosecute the invention of Group 2, claims 10–20. Affirmation of this election must be made by applicant in

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replying to this Office action. Claims 1 – 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claims 11, 13, 16, and 20 are objected to because of the following informalities: claim 11, line 2, "a" should be "said"; claim 13, line 1, "a" should be "said"; claim 16, line 3, "said" should be inserted before "second"; and claim 20, line 8, "patter" should be "pattern".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10-15 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (US 6,322,655).

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Claim 10, Casagrande teaches a method for making an integrated card 47 and business form assembly 21 including introducing tag web 33 having top surface 34 and bottom surfaces 36 into a printing press and printing indicia on web 33 (c 9, L 23-35); applying first layer of lamination 37 on surface 36 using first adhesive means 35; applying second layer lamination 43 over lamination 37 using second adhesive means 41 where web 33 is considered to cool after receiving some level of inherent heat from the printing press (c 9, L 1-35); cutting 47 card in web 33 via cuts 46 (c 9, L 36-61); and cutting a backer in web 33 via cuts 146 .

Claim 11, means 35 is a hold out adhesive which forms a permanent bond between lamination 37 and surface 36 (c 11, L 60-67).

Claim 12, means 35 is applied through the use of pattern coating (c 11, L 21-36).

Claim 13, means 41 is a pressure sensitive adhesive forming a fugitive bond between lamination 37 and lamination 43 (Fig 3, for example).

Claim 14, cuts 46 extend through surface 34, surface 36, and lamination 37 without extending through lamination 43 with card 47 being co-planar web 33 (see drawings).

Claim 15, web 33 includes a border region that surrounds card 47 with card 47 being co-planar with the border region (see drawings).

Claim 19, there is provided forming perforations 63, and cuts 47 may be perforations.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande.

Claims 17-18, Casagrande does not teach using UV cured adhesives for means 35 and 41.

However, UV cured adhesives as permanent and as pressure sensitive are conventional in the art and it would have been obvious to a person of ordinary skill in the art at the time the invention was made replaced the means 35 and 41 of Casagrande with an art recognized alternative adhesive that being UV curable adhesive.

Allowable Subject Matter

9. Claim 16 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 20 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

10. The following is a statement of reasons for the indication of allowable subject matter: claims 16 and 23, Casagrande does not teach that cutting the backer includes forming cuts 146 to extends through lamination 41 and lamination 37 without extending through surface 36 with the backer extending over card 47 and extending over only a portion of surface 36 including the surrounding border region of web 33 with card 47 being releasably attached to web 33 by the backer where for claim 23 McKillip teaches feed holes and perforating thereacross.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda L. Gray whose telephone number is (571) 272-1228. The examiner can normally be reached on Monday-Friday, 9:00am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

llg
February 25, 2007



Linda L. Gray
LINDA GRAY
PRIMARY EXAMINER